

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

RISINGER et al

Examiner: SAKELARIS, SALLY A

Serial No.:

09/943,531

Group Art Unit: 1634 Docket: SGL-2020-UT

Filed: Title:

August 30, 2001 Detection of CYP2C19 Polymorphisms

## **COMMUNICATION**

Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir/Madam,

Applicants herewith submit the documents as listed in PTO/SB/08A Form in compliance with 37 CFR § 1.97(b), after the mailing date of the first office action on the merits, but prior to the final office action. Applicants submitted payment of \$180.00 with the previously filed response as indicated in the courtesy copy of the documents provided herewith.

The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this communication.

Respectfully submitted,

Date 8 AUGUST 7005

BioTechnology Law Group 658 Marsolan Ave.

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CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria,

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8 AUGUT 2005

\_\_\_/

Bruce Grant

Printed Name

Approved for use through 07/31/2006. OMB 0651-0031 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number Application Number 09/943,531 Filing Date TRANSMITTAL 08/30/2001 First Named Inventor RISINGER **FORM** Art Unit 1634 **Examiner Name** SAKELARIS, SALLY A (to be used for all correspondence after initial filing) **Attorney Docket Number** SGL-2020-UT Total Number of Pages in This Submission **ENCLOSURES** (Check all that apply) After Allowance Communication to TC Drawing(s) Fee Transmittal Form Appeal Communication to Board Licensing-related Papers of Appeals and Interferences Fee Attached Appeal Communication to TC Petition (Appeal Notice, Brief, Reply Brief) Amendment/Reply Petition to Convert to a Proprietary Information Provisional Application After Final Power of Attorney, Revocation Status Letter Change of Correspondence Address Affidavits/declaration(s) Other Enclosure(s) (please Identify Terminal Disclaimer below): **Extension of Time Request** Request for Refund **Express Abandonment Request** CD, Number of CD(s) Information Disclosure Statement Landscape Table on CD Certified Copy of Priority Remarks Document(s) Trasmittal (1 page) Courtesy Copy of SB08 - 3 pages Reply to Missing Parts/ Cover letter - 1 pages Incomplete Application Courtesy copy of Supplemental Information Disclosure Statement (2 pages) Reply to Missing Parts return Post card - 1 page under 37 CFR 1.52 or 1.53 enclosed 55 documents SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT Firm Name Biotechnology Law Group Signature Printed name BRUCE D. GRANT

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Signature

Typed or printed name

BRUCE D. GRANT

Date

RANGUST 2015

Date

8 AUGUST

Reg. No.

47,608

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## Application No. 09/943,531





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Serial No.:

09/943,531

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Filed:

August 30, 2001

Docket: SGL-2020-UT

Title:

**DETECTION OF CYP2C19 POLYMORPHISMS** 

## SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir/Madam,

In compliance with the duty under 37 C.F.R. § 1.56, and in accordance with 37 C.F.R. §§ 1.97 et. seq., the enclosed materials are brought to the Examiner's attention for consideration in connection with the above-identified patent application. Applicants respectfully request that this Supplemental Information Disclosure Statement be entered and the documents listed on the attached Form SB08A be considered by the Examiner and made of record. Pursuant to MPEP 609, Applicants request that a copy of the SB08A form, initialed as being considered by the Examiner, be returned to the Applicants with the next official communication. Applicants also bring to the Examiner's attention the existance of two co-pending related applications: (1) application no. 09/942,310 (Attorney Docket: SGL-2019-UT), filed August 29, 2001 and published March 6, 2003 as US20030044797 A1 (Examiner Jeanine Anne Goldberg), and (2) application no. 09/943,115 (Attorney Docket: SGL-2021-UT), filed August 30, 2001 (Examiner Diana B. Johannsen).

The listed documents are being submitted in compliance with 37 CFR § 1.97(b), after the mailing date of the first office action on the merits, but prior to the final office action.

Accordingly, Applicants respectfully submit payment of \$180.00.

The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this communication.

Respectfully submitted,

Date 15 They 2005

BioTechnology Law Group

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CERTIFICATE OF EXPRESS MAIL TRANSMISSION

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Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA \$\frac{2}{2313}\$\div 450 on the date shown below.

Date LODS

Bruce Grant



Subattue for form 1449A/PTO der the Paperwork Reduction Act of 1995, no persons are required to respond to a collection Complete if Known INFORMATION DISCLOSURE **Application Number** 09/943,531 STATEMENT BY APPLICANT Filing Date 08/30/2001 Use as many sheets as necessary) First Named Inventor RISINGER **Group Art Unit** 1634 **Examiner Name** SAKELARIS, SALLY A Attorney Docket No: SGL-2020-UT Sheet 1 of 3

| Examiner   | Cite | USP Document Number | Publication Date | DOCUMENTS  Name of Patentee or | Pages,Columns,Lines,Where Relevant  |
|------------|------|---------------------|------------------|--------------------------------|-------------------------------------|
| initials * | No.1 | OSP Document Number | Publication Date | Applicant of cited Document    | Passages or Relevant Figures Appear |
|            | A1.  | 4,656,127           | 04/07/1987       | MUNDY                          |                                     |
|            | A2.  | 4,683,195           | 07/28/1987       | MULLIS and ERLICH              |                                     |
|            | A3.  | 4,683,202           | 07/28/1987       | MULLIS                         | ·                                   |
|            | A4.  | 4,851,331           | 07/25/1989       | VARY and DIAMOND               |                                     |
|            | A5.  | 4,965,188           | 10/23/1990       | MULLIS and ERLICH              |                                     |
|            | A6.  | 5,547,835           | 08/20/1996       | KOESTER                        |                                     |
|            | A7.  | 5,605,798           | 02/25/1997       | KOESTER                        |                                     |
|            | A8.  | 5,679,524           | 10/21/1997       | NIKIFOROV and KARN             |                                     |
|            | A9.  | 5,691,141           | 11/25/1997       | KOESTER .                      |                                     |
|            | A10. | 5,834,189           | 11/10/1998       | STEVENS and DUNN               |                                     |
|            | A11. | 5,849,542           | 12/15/1998       | REEVE and HOWE                 |                                     |
|            | A12. | 5,851,770           | 12/22/1998       | BABON and YOUIL                |                                     |
|            | A13. | 5,869,242           | 02/09/1998       | KAMB                           |                                     |
|            | A14. | 5,876,934           | 03/02/1999       | DUTHIE and SEVIGNY             |                                     |
|            | A15. | 5,891,625           | 04/06/1999       | BUCHARDT and<br>EGHOLM         |                                     |
|            | A16. | 5,908,755           | 06/01/1999       | KUMAR and HEANEY               |                                     |
|            | A17. | 5,912,118           | 06/15/1999       | ANSORGE and VOSS               |                                     |
|            | A18. | 5,928,906           | 07/27/1999       | KOESTER and VAN<br>DEN BOOM    |                                     |
| ·          | A19. | 5,952,174           | 09/14/1999       | NIKIFOROV and KARN             |                                     |
|            | A20. | 5,958,692           | 09/28/1999       | COTTON and YOUIL               |                                     |

**EXAMINER** 

DATE CONSIDERED

PTC/88/06A(08-03)
Approved for use through 07/31/2008, OMB 0851-0031
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|-------------------------------|---------------------------------|---|--|--|
| INFORMATIONEDISCLOSURE        | Application Number              | 09/943,531  |  |  |
| STATEMENT BY APPLICANT        | Filing Date                     | 08/30/2001  |  |  |
| (a)                           | First Named Inventor            | RISINGER  |  |  |
| 1 0 2005                      | Group Art Unit                  | 1634  |  |  |
| MIG 1 0 2003                  | Examiner Name                   | SAKELARIS, SALLY A  |  |  |
| Sheet 2 of 3                  | Attorney Docket No: SGL-2020-UT |   |  |  |
| PRADE!                        |                                 |   |  |  |

| 014- | LISP Document Number  |                  | DOCUMENTS   | Pages,Columns,Lines,Where Relevant  |
|------|---|------------------|---|---|
| No.1 | USP Document Number   | Publication Date | Applicant of cited Document   | Passages or Relevant Figures Appear   |
| A21. | 5,976,802   | 11/02/1999       | ANSORGE and VOSS  | -   |
| A22. |   | 11/09/1999       | GABE and GILCHRIST  |   |
| A23. |   | 12/07/1999       | ELLIS and DODGE   |   |
| A24. |   | 12/21/1999       | GOELET and KNAPP  |   |
| A25. |   | 01/11/2000       | SOEDERLUND and SYVANEN  |   |
| A26. | 6,013,499   | 01/11/2000       | NARUMIYA and<br>IWAMATSU  |   |
| A27. | 6,017,702   | 01/25/2000       | LEE and ROSENBLUM   |   |
| A28. | 6,043,031   | 03/28/2000       | KOESTER and<br>HIGGENS  |   |
| A29. | 6,046,005   | 04/04/2000       | JU and KONRAD   | ·   |
| A30. | 6,087,095   | 07/11/2000       | ROSENTHAL and BRENNER   |   |
| A31. | 6.110.684   | 08/29/2000       | KEMPER and<br>BIRKENKAMP-<br>DEMTROEDER   |   |
| A32. | 6,183,958   | 02/06/2001       | STANTON   |   |
| A33. | 6,194,144   | 02/27/2001       | KOESTER   |   |
| A34. | 6,210,891   | 04/03/2001       |   |   |
| A35. | 6,229,911   | 05/08/2001       | BALABAN and<br>AGGARWAL   |   |
| A36. |   |                  |   |   |
| A37. |   |                  |   |   |
| A38. |   |                  |   |   |
|      | A21. A22. A23. A24. A25. A26. A27. A28. A29. A30. A31. A32. A33. A34. A35. A36. | No.¹  A21.       | No.¹       11/02/1999         A21.       5,976,802         A22.       11/09/1999         5,981,186       12/07/1999         A23.       12/07/1999         5,998,143       12/21/1999         A24.       6,004,744         A25.       6,013,431         A26.       01/11/2000         6,013,499       01/25/2000         A27.       01/25/2000         6,017,702       03/28/2000         A28.       6,043,031         A29.       04/04/2000         6,046,005       07/11/2000         A30.       6,087,095         A31.       08/29/2000         6,110,684       02/06/2001         A32.       6,183,958         A33.       02/27/2001         6,210,891       05/08/2001         A35.       6,229,911         A36.       A37. | No.1         Applicant of cited Document           A21.         5,976,802         ANSORGE and VOSS           A22.         11/09/1999         GABE and GILCHRIST           5,981,186         12/07/1999         ELLIS and DODGE           A23.         5,998,143         12/21/1999         GOELET and KNAPP           6,004,744         12/21/1999         GOELET and KNAPP           A25.         6,013,431         NARUMIYA and IWAMATSU           A26.         01/11/2000         NARUMIYA and IWAMATSU           A27.         6,017,702         LEE and ROSENBLUM           A28.         6,043,031         KOESTER and HIGGENS           A29.         04/04/2000         JU and KONRAD           A30.         6,046,005         ROSENTHAL and BRENNER           A31.         08/29/2000         KEMPER and BIRKENKAMP-DEMTROEDER           A32.         02/06/2001         STANTON           A33.         6,183,958         02/27/2001         KOESTER           A34.         04/03/2001         NYREN and UHLEN           A35.         6,229,911         05/08/2001         BALABAN and AGGARWAL |

| A38. |    |             |              |  |
|------|----|-------------|--------------|--|
|      | F( | DREIGN PATE | NT DOCUMENTS |  |

PTC/6B/084(08-03)
Approved for use through 07/31/2008. OMB 0651-0031
US Palent & Trademark Office. U.S. DEPARTMENT OF COMMERCE

| Substitute for form 1449A/PTO                    | Complete if Known               | equired to respond to a collection of information unless it contains a valid OMB control number |  |  |
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| ( ) ( )  | First Named Inventor            | RISINGER  |  |  |
| ( AU6 1 0 2005 <sup>57</sup> )                   | Group Art Unit                  | 1634  |  |  |
| PA S   | Examiner Name                   | SAKELARIS, SALLY A  |  |  |
| Sheet 3 10                                       | Attorney Docket No: SGL-2020-UT |   |  |  |
| PANEILL  |                                 |   |  |  |

| Examiner<br>Initials* | Cite<br>No.' | Foreign Document No | Publication Date | Name of Patentee or Applicant of cited Document | Pages,Columns,Lines,<br>Where Relevant<br>Passages or Relevant<br>Figures Appear | T² |
|-----------------------|--------------|---------------------|------------------|---|--|----|
|                       | A39.         | WO0120039           | 03/22/2001       | ROTHBERG and BADER                              |  |    |
|                       | A40.         | WO0127326           | 04/19/2001       | EGHOLM and CHEN                                 |  |    |
|                       | A41.         | WO0127327           | 04/19/2001       | BRENNAN and<br>CHATELAIN                        |  |    |
|                       | A42.         | WO0127329           | 04/19/2001       | MACLEOD and ALDAZ                               |  |    |
|                       | A43.         |                     |                  |   |  |    |
|                       | A44.         |                     | 1                |   |  |    |

| Examiner      | Cite | R DOCUMENTS NON PATENT LITERATURE DOCUMENTS  Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item | Ta  |
|---------------|------|--|-----|
| initials*     | No 1 | (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.      |     |
|               | A45. | ANDERSON et al., Pharmacogenetics,, 2(1):25-31 (1992)  |     |
|               | A46. | BALIAN et al., Clin. Pharmacol. Ther., 57(6):662-669 (1995)  | Ì., |
|               | A47. | BERTILSSON, Clin. Pharmacokinet., 29(3):192-209 (1995)   |     |
|               | A48. | CHANG et al., Br. J. clin. Pharmac., 39:511-518 (1995)   |     |
|               | A49. | EVANS et al., Pharmacogenetics, 5(2):64-71 (1995)  |     |
|               | A50. | GOLDSTEIN et al., Biochemistry, 33(7):1743-1752 (1994)   |     |
|               | A51. | GOLDSTEIN et al., Pharmacogenetics, 7(1):59-64 (1997)  |     |
|               | A52. | GOLDSTEIN, Br. J. clin. Pharmac., 52:349-355 (2001)  |     |
| <del></del>   | A53. | IBEANU et al, J. Pharmacol. Exp. Ther., 290(2):635-640 (1999)  |     |
| · <del></del> | A54. | IEIRI et al., Clin. Pharmacol. Ther., 59(6):647-653 (1996)   |     |
|               | A55. | MACAULAY et al., Science, 308:1034-1036 (2005)   |     |
|               | A56. | MEYER and ZANGER, Annu. Rev. Pharmacol. Toxicol., 37:269-296 (1997)  |     |
|               | A57. | RICHARDS et al, Am. J. Hum. Genet. 67:1251-1276 (2000)   |     |
|               | A58. | TANAKA, J Clin Pharm Ther., 24:323-329 (1999)  |     |
| <del></del>   | A59. | WILKINSON et al., Pharmac. Ther. 43:53-76 (1989)   |     |
|               | A60. | YIN et al., J. Clin. Pharmacol. 44:582-589 (2004)  |     |
|               | A61. |  |     |
| <del> </del>  | A62. |  |     |

EXAMINER DATE CONSIDERED